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PATENT  
0EKM-104792

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/662,619 Confirmation No. 9762  
Applicants : Hyun Jin Kim et al.  
Filed : September 15, 2003  
TC/A.U. : 3711  
Examiner : Raeann Gordon  
  
Docket No. : 0EKM-104792  
Customer No. : 30764

September 21, 2004

VIA FACSIMILE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Non-Final Office Action mailed August 27, 2004. On page 2 of the Office Action, the Examiner required a restriction to one of the following inventions:

- I. Claims 1-[40], drawn to a golf ball [including a composition] . . . ;
- II. Claims [41]-47, drawn to a method [for manufacturing a golf ball] . . .

In the Office Action, it appears that the Examiner mistakenly included claim 41 in Group I instead of Group II.

In response to the restriction requirement, Applicants elect the invention of Group I, drawn to a golf ball including a composition, with traverse. In the restriction requirement, the Examiner alleges that the application includes two distinct inventions. Specifically, the Examiner identifies Group I, claims 1-40, which are drawn to a golf ball

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Response dated September 21, 2004  
Reply to Office Action of August 27, 2004

including a composition, as allegedly distinct from Group II, claims 41-47, drawn to a method for manufacturing a golf ball. The Examiner alleges that the golf ball including a composition of Group I can be made using a process that is materially different from that claimed in claim 41. Applicants respectfully disagree.

Group II includes independent claim 41 and its dependent claims 42-47.

Claim 41 recites a method for manufacturing a golf ball that includes providing the components of a composition, preparing the composition, and forming the composition into the golf ball. Any allegedly different process for manufacturing the golf ball including the composition of claim 1 would fall within the scope of claim 41, and thus, it cannot be considered materially different from the invention recited in claim 1. The claimed product, *i.e.*, the golf ball having the composition, cannot be made by a method other than that recited in claim 41, *i.e.*, a method of manufacturing the golf ball having the composition.

Moreover, Applicants respectfully request the Examiner to reconsider the restriction requirement between Group I and Group II because there is no additional burden to search and examine the two groups of claims together. Specifically, the claims of Group II describe a process for manufacturing a golf ball including the composition that is the subject of claim 1. The search and examination can proceed on the basis of claim 1. As such, there is no additional burden on the part of the U.S. Patent and Trademark Office to examine claims 1-40 together with claims 41-47. According to MPEP § 803, if the search and examination of patent claims can be made without serious burden, the Examiner must examine the patent claims on their merits, even though the application allegedly includes claims to independent or distinct inventions.

In addition to the above rule, the MPEP also provides for rejoinder of claims subject to a restriction requirement. According to MPEP § 821.04, non-elected process claims can be rejoined after an elected product claims is allowed if the process claims depend upon or otherwise include all of the limitations of the allowable product claim. This rule applies here. Therefore, claims 1-40 should be examined together with claims 41-47.

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For the above reasons, Applicants respectfully request the withdrawal of the restriction requirement between Groups I and II.

Now, this application should be in condition for a favorable substantive examination. Early issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,  
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: 

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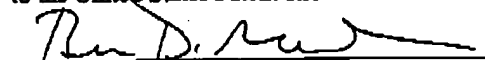
Re: Transmittal of Response to Restriction Requirement

*John 5:09 p.m.*

MESSAGE: Please see attached.

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Brian D. Martin, Esquire

**Response to Restriction Requirement**

Applicants: Hyun Jin Kim et al.

Title: GOLF BALLS INCORPORATING PEPTIZERS  
AND METHOD OF MANUFACTURE

Serial No: 10/662,619

Filed: September 15, 2003

Examiner: Raeann Gordon

Group Art Unit: 3711

Our Docket No.: OEKM-104792

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Date Due: 09/25/04

Atty/Sec.: Martin/Kemp

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